

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claim Amendments

Claims 1-33 are canceled above.

New claims 34-49 are added above. Support for the new claims may be found throughout the specification as filed and in claims 1-33 as originally filed. The following table correlates the newly presented claims with exemplary support in the specification as filed and in the claims as originally filed.

Newly presented claim	Support in Specification
34	Original claim 16; pages 4-5, [0018]; page 32 [0117]
35	Original claim 18; page 4, [0015]; page 32 [0117]
36	Original claim 20; page 4, [0016]; page 32 [0117]
37	Original claim 22; page 4, [0016]
38	Original claim 23; page 4, [0016]
39	Original claim 4; page 2, [0007] ; pages 2-3, [0009] ; page 16, [0062] ; page 30, [0111]
40	Original claim 9; page 12, [0051]
41	Original claim 10; page 12, [0051]
42	page 5, [0021]; page 32, [0119]
43	page 5, [0021]; page 32, [0119]
44	page 5, [0021]; page 32, [0119]
45	page 5, [0021]; page 32, [0119]
46	page 5, [0021]; page 32, [0119]
47	page 5, [0021]; page 32, [0119]
48	page 5, [0021]; page 32, [0119]
49	page 5, [0021]; page 32, [0119]

Applicants confirm that the currently presented claims falls within the scope of the elected group.

Applicants submit that no new matter is added by any of the above amendments and entry of these amendments is therefore respectfully requested. Applicants specifically reserve the right to file continuing applications directed to any canceled subject matter.

Information Disclosure Statement

Applicants submit on even date herewith a Supplemental Information Disclosure Statement and request consideration of the references identified therein by the Office.

Interview Summary

Applicants thank Examiners Teller and Tate for the courtesy extended to the undersigned, Gerald Swiss (Reg. No. 30,113), and James Nesbitt (Reg. No. 54,575) during an in-person interview held on January 26, 2009 to discuss the above-noted application. During the interview, no exhibit was shown nor was any demonstration conducted.

During the interview, previously pending claims 1-33 were discussed. Particularly, inclusion of the term “heterocyclic carbonyl glycine compound which inhibits a HIF hydroxylase” into the claims was discussed. The Interview Summary Form PTOL-413 (Paper No. 0109) provided by Examiner Tate is accurate.

The amendments provided above reflect what was discussed during the interview.

Nonstatutory Obviousness-type Double Patenting

Claims 1, 3-14, 16, 18, 20, 22-24, 26 and 28-31 were provisionally rejected under the nonstatutory obviousness-type double patenting rejection for allegedly being unpatentable over claims 1-11 of U.S. Patent Application Number 10/313,643.

Applicants point out that U.S. Patent Application Number 10/313,643 is abandoned. Additionally, claims 1, 3-14, 16, 18, 20, 22-24, 26 and 28-31 are canceled above. Therefore, the provisional nonstatutory obviousness-type double patenting rejection of claims 1, 3-14, 16, 18, 20, 22-24, 26 and 28-31 is moot, and Applicants respectfully request withdrawal of this rejection.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 1-31 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable in view of (1) the combined teachings of Edwards et al. (U.S. Patent No. 5,916,898) in view of Müller (EP 0 878 480) and (2) Guenzler et al. (International Publication No. WO 03/049686). Claims 1-31 are canceled above; therefore, this rejection is moot as to these claims. In order to expedite prosecution, Applicants will discuss these previous rejections in light of newly presented claims 34-49. Applicants submit that new claims 34-49 recite limitations that are not encompassed, taught, or supported by any of the teachings of Edwards et al., Müller, or Guenzler et al., singly or in combination. These previous rejections are thus not relevant to new claims 34-49.

The test for non-obviousness articulated by the Court of Appeals for the Federal Circuit in *In re Vaeck* requires consideration of at least the following factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should practice the claimed invention; and (2) whether the prior art would also have provided a reasonable expectation of success to such a skilled artisan. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The first requirement goes to the question of motivation, and refers to a line of well established cases that there must be some logical reason at the time of the invention for modifying the cited references along the lines of the invention; otherwise the use of the teachings as evidence of non-obviousness will entail prohibited hindsight. *Ex parte Stauber and Eberle*, 208 USPQ 945 (Bd. App. 1980). For at least the reasons presented below, Applicants submit that current claims 34-49 are non-obvious in view of Edwards et al., Müller, and Guenzler et al., singly or in combination.

1. Edwards et al. (U.S. Patent No. 5,916,898) in view of Müller (European Patent No. 0 8978 480)

Claims 1-31 were rejected under 35 U.S.C. 103(a) as obvious over the combined teachings of Edwards et al. (U.S. Patent No. 5,916,898) in view of Müller (EP 0 878 480). Claims 1-31 are canceled above; therefore, this rejection is moot as to these claims. As stated above, Applicants submit that this rejection is not relevant to new claims 34-49.

In making the previous rejection, the Office stated that “it would have been *prima facie* obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the teachings from Edwards et al. with those from Müller...” and from the teachings of the references, “it is apparent that one

of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention.” (Office Action, page 6.)

Edwards et al. is directed to phenanthroline derivatives useful for inhibiting prolyl 4-hydroxylase and to their use in producing an anti-fibroproliferative effect. (See Edwards et al. at page 2, column 1, lines 43-44, and at page 1 in the abstract.) Edwards et al. does not teach or suggest using the phenanthroline compounds described therein for treating obesity, regulating body weight, or reducing body fat in a subject in need thereof, as recited in new claims 34-49. Additionally, Edwards et al. provides no teaching or suggestion that administration of a heterocyclic carbonyl glycine compound which inhibits a hypoxia inducible factor hydroxylase, as recited in newly presenting claims 34-49, would be effective at treating obesity, regulating body weight, or reducing body fat. Therefore, new claims 34-49 are non-obvious in view of Edwards et al.

Müller does not cure the deficiencies of Edwards et al. Specifically, Müller is directed to “a method for the improvement of neuronal regeneration, a medicament for the improvement of neuronal regeneration and use of an inhibitor substance. (See Müller at page 2, column 1, lines 3-6.) In particular, Müller teaches preventing or inhibiting basal membrane formation by applying an inhibitor substance of the synthesis and/or assembly of basal membrane building elements. (See Müller at page 1, column 1, lines 25-48.) Müller does not teach or suggest using an inhibitor substance for treating obesity, regulating body weight, or reducing body fat in a subject in need thereof, as recited in new claims 34-49. Additionally, Müller provides no teaching or suggestion that administration of a heterocyclic carbonyl glycine compound which inhibits a hypoxia inducible factor hydroxylase, as recited in newly presented claims 34-49, would be effective at treating obesity, regulating body weight, or reducing body fat. Therefore, new claims 34-49 are non-obvious in view of Müller.

Accordingly, Edwards et al. and Müller, taken singly or in combination, do not allow one of skill in the art to arrive at the currently claimed invention. In making the previous rejection to now canceled claims 1-31, the Office alleged on page 6 of the Office Action that:

[t]he prior art references cited above do not enumerate the regulating of fat metabolism as claimed in the instant invention. However, adjustment of particular conventional working conditions (e.g., the administration of HIF alpha to a subject) is deemed merely a matter of judicious selection and routine optimization of a result-effective parameter that is well within the purview of the skilled artisan.

However, this analysis is not applicable to currently pending claims 34-49. The current claims do not in any way relate to adjustment of particular conventional working conditions. In particular, newly presented claims 34-49 recite a new use for specific compounds, i.e., heterocyclic carbonyl glycine compounds which inhibit a hypoxia inducible factor hydroxylase.

In summary, Applicants submit that neither Edwards et al. nor Müller provide any teaching or suggestion of treating obesity, regulating body weight, and reducing body fat by administering a “heterocyclic carbonyl glycine compound which inhibits a hypoxia inducible factor (HIF) hydroxylase” as recited in new claims 34-49. Therefore, the teachings of these references fail to provide one of skill in the art in arriving at the claimed invention. Accordingly, new claims 34-49 are non-obvious in view of these references.

2. Guenzler et al. (WO 03/049868)

The Examiner rejected now canceled claims 1-31 under 35 U.S.C. 103(a) as being unpatentable over Guenzler et al. (WO 03/049868). This rejection is moot in view of the cancellation of these claims. As stated above, Applicants submit that this rejection is not relevant to new claims 34-49.

In making the previous rejection, the Examiner stated on page 7 of the Office Action that:

Claims 1-11 of the referenced '686 application are drawn to a method comprising the same ingredients and essentially the same steps to obtain a method as claimed in the recited claims of instant application. It would have been obvious to one of ordinary skill in the art to substitute the method for stabilizing the alpha subunit of HIF alpha in a subject of the referenced application with a method of regulating fat metabolism in a subject....

Guenzler et al. does not teach or suggest methods for treating obesity, regulating body weight, or reducing body fat in a subject in need thereof as recited in newly presented claims 34-49. Accordingly, Guenzler et al. fails to provide any teaching or suggestion that administration of a heterocyclic carbonyl glycine compound which inhibits a hypoxia inducible factor hydroxylase, would be effective at treating obesity, regulating body weight, or reducing body fat as recited in newly presented claims 34-49. Therefore, new claims 34-49 are non-obvious in view of Guenzler et al.

CONCLUSION

The courtesy extended by the Examiner in the in-person interview held on 26 January 2009 is much appreciated. Applicants believe that the present application, in which previously pending claims 1-31 are now canceled and new claims 34-49 are now added, is now in condition for allowance.

Applicants claim small entity status under 37 C.F.R. 1.27.

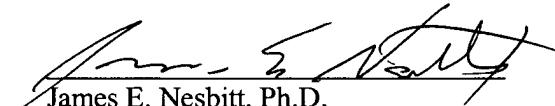
The Commissioner is hereby authorized to charge the total of any fee necessary in this communication to Deposit Account No. 50-0811, referencing Docket No. FP0602.2 US.

Please call Applicant's representative at 415-978-1744 with any questions regarding the present communication or the above-identified application.

Respectfully submitted,

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By:


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